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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,350	12/20/2001	Christopher Peggs	PEGG3001/REF	2605
7590	03/21/2005		EXAMINER	
Richard E. Fichter BACON & THOMAS, PLLC 625 Slaters Lane Alexandria, VA 22314-1176			RODRIGUEZ, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<i>Office Action Summary</i>	Application No.	Applicant(s)
	10/022,350	PEGGS, CHRISTOPHER
	Examiner Joseph C Rodriguez	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,5-12 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 1,5-12,16 and 17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 18-20 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/29/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____.

***Final Rejection***

Applicant's arguments filed 2/19/04 and 12/22/04 have been fully considered but they are not persuasive for reasons detailed below.

The 35 U.S.C. 112 rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 19 and 20, the phrase "whip-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "-like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Further, claim 19 depends off of a withdrawn claim, thus rendering the scope of the claims indefinite if the claims are passed to issue and claim 1 cancelled. Examiner recommends including the contents of withdrawn claim 1 into claim 19.

The prior art rejections are maintained or modified as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Eide et al. ("Eide") (US 5,188,500)

Eide (Fig. 1) teaches a method for splitting bags comprising introducing at least one bag containing solid waste to a waste feed guide structure which directs the bag to bag splitting apparatus (Fig. 1) having a rotatable flail structure having a plurality of flexible flails (14) attached to a rotatable mounting (12) and rotating the flexible flails at a "relatively" high speed of rotation to provide a whip-like cutting action to tear open the bags (Abstract; col. 3, ln. 16-col. 5, ln. 56). Here, Eide teaches the further processing of the bag contents and does not teach the destruction of the bag contents during the tearing of said bag thus the method taught by Eide is regarded as "causing minimal damage to the solid contents of the bag". Further, the term "whip-like" is regarded as using some impact force, thus rotating the flails and using the force of flails to split or tear the bags can be regarded as "whip like" (col. 4, ln. 15-63). Further, Applicant is respectfully reminded that to be entitled to patentable weight in method claims, the structural limitations recited therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 31 (1961). Here, the structural limitations cited via reference to

claims 1 and 18 do not impact the method as required, thus amounting to the mere claiming of a use of a particular structure.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Andela (US 5,944,268).

Andela (Fig. 1-6) teaches, an apparatus comprising a rotatable flail structure having a plurality of flexible flails (Fig. 4-6, flails 42, 50; col. 4, ln. 66 et seq.; col. 3, ln. 5-10 describing coating of different flail-types, such as chain, with plastic) attached to a rotatable mounting (32) and a waste feed guide (Fig. 6, top near arrow). Here, it is noted that plastic has a Young's modulus of less than 50 GN/m<sup>2</sup>. Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the flails are certainly capable of creating a "whip-like" cutting action to tear open plastic bags as Andela teaches the rotation of the flails as capable of pulverizing glass thus it is implicit that a speed high enough to tear plastic bags is used.

### ***Response to Arguments***

Applicant's arguments that the prior art fails to teach the claimed features are unpersuasive. In particular, Applicant emphasizes that the prior art is incapable of providing a "whip-like" cutting actions. Here, it is first noted that the language "like" renders the claim language indefinite and broadens the interpretation of the claimed

invention considerable. For example, it is unclear why the “any desired speed” or the 120 RPM taught by Dongieux can not be regarded as “whip-like” or as a “relatively high speed of rotation”. Further, it is worth noting again that functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. This is especially applicable in the present situation as the prior art devices are certainly capable of creating a “whip-like” cutting action that tears open plastic bags. Indeed, it is unnecessary for the prior art to teach the specific capability as argued by Applicant as the prior art must only be “capable of” functioning as claimed. Further, as previously argued, the prior art devices, with proper gearing and a powerful enough motor, would be capable of rotating the flail structure hundreds of times per millisecond. Consequently, the claims stand rejected.

### ***Specification***

The disclosure is objected to as lacking appropriate section headings as outlined in 37 CFR 1.77. See also 37 CFR 1.72-1.77; MPEP § 608.01(a). Correction is required.

### ***Election/Restrictions***

Applicant's election, based on the status identifiers of 12/22/04, with traverse of claims 18-20 in the reply filed on 12/22/04 is acknowledged. The traversal is on the grounds that the non-elected claims are not patentably distinct. This is not found persuasive as a review of the withdrawn claims indicates several apparatus claims that

are distinct from the elected method claims based on a method-apparatus restriction.

See MPEP 806.05(e). Further, these claims stand withdrawn by the previous Examiner based on election by original presentation, wherein the presently elected claims represent the originally examined subject matter.

The requirement is still deemed proper and is therefore made FINAL.

Further, a complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Further, the examiner is tentatively scheduled to move in April 2005 and the contact info at the new location will be as follows:

**April 2005, Personal telephone number is 571-272-6942**

**April 2005, UNOFFICIAL Personal fax number is 571-273-6942**

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

**<http://pair-direct.uspto.gov>**

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Signed by Examiner Joseph Rodriguez

jcr

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March 15, 2005

  
DONALD P. VANCIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600